

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Art Unit: 2432

Kenen et al.

Confirmation No.: 7867

Application No.: 10/816,175

Filed: March 31, 2004

For: DOCUMENT VERIFICATION USING
JURISDICTIONAL INFORMATION TO
EXTRACT A DIGITAL WATERMARK

Via Electronic Filing

Examiner: M. San Juan

Date: April 3, 2009

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Appellants request review of the final rejection in the above-identified application. No amendment is being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheets. (No more than 5 pages are provided.)

Date: April 3, 2009

Respectfully submitted,
DIGIMARC CORPORATION

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By /Joel R. Meyer/
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REASONS FOR REQUEST FOR PRE-APPEAL REVIEW

Sir:

Responsive to the final Office Action dated November 3, 2008, Applicants file herewith a notice of appeal, a request for pre-appeal brief review, and the following reasons for requesting the pre-appeal review.

Claims 21-22 and 24-28 are rejected under 35 U.S.C. Section 102(b) as being anticipated by US Patent Publication 2001/0037455 to Lawandy et al. ("Lawandy").

Claims 23 and 31 are rejected under 35 U.S.C. Section 103(a) as being unpatentable over Lawandy in view of U.S. Patent No. 5,694,471 to Chen et al. ("Chen").

Claims 29 and 30 are rejected under 35 U.S.C. Section 103(a) as being unpatentable over Lawandy in view of PCT Publication WO/2001/095249 by Hudson et al. ("Hudson").

Lawandy does not disclose all of the elements of claims 21-22 and 24-28, and therefore cannot anticipate these claims. Regarding claim 21 for example, Lawandy does not teach "determining jurisdictional information related to the document." The Office contends that Lawandy's teaching of semantic information, such as ownership information in paragraph [0003], is synonymous to jurisdictional information. However, there is no teaching in Lawandy that discloses that such semantic information corresponds to jurisdictional information. Much less, Lawandy fails to teach the act of determining jurisdictional information related to the document as recited in 21. In essence, the Office reduces an active element of claim 1 of

“determining jurisdictional information...” to merely a claim element of “information” with no patentable weight relative to different types of information. This is improper because the claim actively recites “determining jurisdictional information related to the document” in combination with other elements positively reciting further acts that use this jurisdictional information, including using the jurisdictional information to obtain a watermark key which is related to a digital watermark embedded in the document.

The dependent claims include additional elements that are also not disclosed in Lawandy. For example, regarding claim 27, the Office cites Lawandy at paragraphs [0044] to [0048] as disclosing the following claim elements: “the jurisdictional information is mathematically related to the digital watermark through a cryptographic relationship.” The cited passage of Lawandy specifically mentions a function for generating a digital watermark using a taggant as coding information that serves as a seed to a random number generator. The random number is “used as a hash, or some other one-way function for generating the digital watermark.” [0044] The coding information is not disclosed to be jurisdictional information, and the coding information is not disclosed to be mathematically related to the digital watermark through a cryptographic relationship. Therefore, Lawandy cannot anticipate claim 27.

The combination of Lawandy and Chen does not render the claims obvious. Regarding claim 23, for example, the Office further relies on Chen, but Chen does not provide the elements of claim 23 missing from Lawandy cited above. Chen uses a pointer to look up a decryption key used in a process of verifying a digital signature to determine if it has been altered. Chen provides no teaching regarding the use of a key to extract a digital watermark. As such, one of ordinary skill in the art would not find useful teaching in Chen that would reasonably lead to modifying Lawandy in a manner that would suggest that the taggant in Lawandy should be used to obtain a watermark key as claimed.

Regarding claim 31, the Office has cited a passage of Chen (col. 1, lines 32-51) that generally refers to private-public key pairs, but contrary to the Office’s suggestion, there is no relationship in Chen among elements on a document that are related “through a public-private key pair” as claimed. Note in particular that Chen’s system teaches storing a digital signature on a card, but there is no teaching that this digital signature is related to other elements on the card through a public-private key pair as claimed. Therefore, since Lawandy also lacks this element,

the combination of Chen's teaching with Lawandy does not teach or suggest all of the elements of claim 31.

Moreover, Chen provides no teaching regarding watermarking or watermarking keys nor relationships among elements on a document, and therefore, one of ordinary skill in the art would not derive useful teachings from Chen to modify Lawandy to make the method of claim 31. One of skill in the art would not discern from these teachings a suggestion of a relationship between Chen's digital signature and a digital watermark or watermark key that would lead one of skill in the art to apply the digital signature verification technique in Chen in some fashion to form a public-private key pair relationship between Lawandy's watermark and machine readable data on Lawandy's document. A relationship between a key and digital signature does not suggest a relationship with a watermark as claimed. Moreover, Since Chen's key-digital signature relationship is not between elements on a document, it is even further removed from the claimed method and does not suggest a combination with Lawandy's teachings of a watermark and machine readable data. Finally, neither Lawandy nor Chen suggests a watermark in an optically variable device recited in claim 31 through its dependence on claim 29.

Regarding the other claims, Applicants arguments still apply but are omitted here to focus the issues for the pre-appeal review.

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